



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,706	11/06/2000	Robert J Briscoe	36-1384	3584

23117 7590 01/09/2009
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
----------	--------------

3696

MAIL DATE	DELIVERY MODE
-----------	---------------

01/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/674,706

Applicant(s)

BRISCOE ET AL.

Examiner

Ella Colbert

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-25, 30, 32, 33 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-25, 30, 32, 33 and 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/04/07 & 11/19/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 4-25, 30, 32, 33, and 39-46 are pending. Claims 1, 17, and 46 have been amended in this communication filed 09/13/06 entered as Response After Non-Final action and the Status Letter filed 11/19/08.
2. The IDSs filed 06/04/07 and 11/19/08 have been entered and considered.
2. The objections to claims 1 and 46 have been overcome by Applicants' amendment and the objection to claim 14 has been overcome by Applicants' convincing arguments and the claim objections for claims 1, 14, and 46 are hereby withdrawn.
3. The 35 USC 112 second paragraph rejection for claims 17 and 46 in the Office action of 06/12/06 have been overcome by Applicants' amendments to claims 17 and 46 and are hereby withdrawn. However, after a thorough review of the claims there are still remaining 35 USC 112 second paragraph issues.
4. Applicants' arguments are considered moot in view of the new ground(s) of rejection as set forth here below.

Claim Objections

5. Claim 16 is objected to because of the following informalities: recites "further communicating ..." on page 3. This claim limitation is in improper method claim format. The claim limitation should be recited as "communicating ...". Claim 46 has a similar problem. Claim 46 (a) recites "each terminal measuring ...;". This claim limitation should recite "measuring with respect to each terminal the amount of network resources which each terminal uses;". Step (b) has a similar problem with the usage of "its use" in the claim limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Claim 1 after step a) has a step missing which includes "each of the plurality of customer terminals usage". Another step is missing after step b) because there is not another step with "calculating the network usage charge" or another step once the network usage charge is generated from the measurement data. The claim limitations jumps to "sampling usage of the network resources ...". There is a disconnect between steps b) and c). Suggestion for step (i) "measuring a portion of the usage of the network resources by at least one of the customer service terminals" and for step (ii) comparing the measurement of the network resources in step (c) (i), with respect to the sampled usage ...".

Claim 46 has a similar problem.

Claims 4-25, 30, 32, 33, and 39-45 are also rejected because of their dependency on a rejected base claim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3696

9. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites "A method ..., wherein sampling the usage in step (c) is carried out by a network operator and sampling the usage in step (c) comprises sampling part only of the traffic ..., ..., and ...". This claim limitation would be better recited for clarity as "A method ..., wherein sampling the usage in step (c) is performed by a network operator and sampling the usage in step (c) comprises sampling only part of the traffic ..., ..., and ...".

Conclusion

10. Suggestions for some subject matter that might be incorporated into the independent claim limitations are as follows:

Measuring usage of network resources at each of a plurality of customer terminals, sampling usage of the network resources by a customer terminal by measuring a portion of the usage only by that terminal; comparing the measured portion of the usage with the usage measured at the customer terminal or usage charge calculated from the usage measured at the customer terminal; monitoring by the network a sample of actual network usage as a policing measure and checking that the sampled usage corresponds to the usage and/or cost reported by the corresponding terminal; monitoring the network does not continuously include monitoring all of the usage by each individual terminal but does include occasionally spot checking or sampling to ensure users are reporting their usage honestly and correctly thereby reducing the burden on the network.

Applicants' need to make sure there are not any omission of essential steps amounting to a gap between the steps with any added claim limitations in the independent claims.

After the claim amendments have been made an extensive search will be performed and if no other issues with the claims remain or no new prior art is found to reject the claims, the application will be passed to issue.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

November 26, 2008